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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,156	01/22/2002	Jorge Abel Groiso	NIE-0003-US	7921
28970	7590	05/26/2004	EXAMINER	
SHAW PITTMAN			PRIDDY, MICHAEL B	
IP GROUP			ART UNIT	PAPER NUMBER
1650 TYSONS BOULEVARD			3732	
SUITE 1300				
MCLEAN, VA 22102			DATE MAILED: 05/26/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/051,156	GROISO, JORGE ABEL
	Examiner Michael B Priddy	Art Unit 3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3,7-10 and 14-16 is/are rejected.
- 7) Claim(s) 4-6,11-13 and 17-21 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Objections***

Claim 4 is objected to because of the following informalities: in line 5, "said staple" should be –the staple of claim 1--. Appropriate correction is required.

Claim 11 is objected to because of the following informalities: in line 4, "said staple" should be –the staple of claim 7--. Appropriate correction is required.

Claim 17 is objected to because of the following informalities: in line 4 "said staple should be --the staple of claim 14--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2 and 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Jobe (U.S. 5,787,713). Jobe teaches a bone staple 70 capable of correcting bone deficiencies by controlling the growth of the epiphyseal plate, the staple comprising: a shape memory material body comprising a cross bar 74 and at least two legs 72

extending from the cross bar. The cross bar 74 is resiliently deformable between an initial orientation and an insertion orientation upon application of a force to the cross bar 74. The legs 72 are oriented at an angle relative to the opposite leg 72 when the body portion is in the initial orientation and the legs 72 are substantially parallel when the body portion is moved to the insertion orientation for insertion of the legs 72 into tissue. The leg portions at least partially return to the initial orientation when the force applied to the cross bar 74 is released such that the legs 72 anchor the staple 70 to the tissue. As shown in Fig. 16, the legs may be "initially directed outwardly" such that they diverge. Concerning the language of claim 2, the embodiment of Fig. 16 clearly shows each leg at an angle of greater than 90° relative to the cross bar 74. Furthermore, cross bar 74 extends beyond a corner joint between the cross bar 74 and the legs 72 forming a curved shoulder means (Exhibit A) for abutting the bone and the cross bar defines an arc shape.

Concerning the limitations of claim 9, the embodiment of Fig. 17 shows a staple 70 having reinforcing means 78 at each corner joint between the legs 72 and the cross bar 74.

Claims 14 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Oberlander (U.S. 6,554,852). Oberlander teaches a bone staple comprising: a body comprising a cross bar 31 and at least two legs 21 extending from the cross bar 31, wherein each leg includes an helical thread designed for anchoring into the bone, the cross bar 31 being capable of being cut; the helical thread defining a screw in each leg 21 of the staple.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jobe.

Jobe discloses the claimed invention except for the staple body being made of nitinol. It would have been obvious to one having ordinary skill in the art at the time the invention was made construct the staple body of nitinol since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oberlander in view of Archuleta et al. (U.S. 5,425,407). Oberlander, as presented in the above rejections under 35 U.S.C. 102(b), teaches all of the limitations of the present invention except the helical thread is defined by a longitudinal cross section comprising an upper flat plane and a lower inclined plane, both planes helically extending around the corresponding leg. Archuleta et al. teaches a screw 50 having a buttress thread 22. As described in lines 35-40 of column 2, a buttress thread has an upper pressure face or flank which is substantially perpendicular to the central axis while the lower, or buttress face or flank, has a generally plane surface whose cross-section is about 25 to 55 degrees from the axial direction. This type of thread design results in less resistance

to insertion and greater resistance to forcible ejection. It would have been obvious to one of ordinary skill in the art at the time of the present invention to form the thread of Oberlander as a buttress thread so as to allow for easy installation of legs 21 while decreasing probability of ejection.

### ***Allowable Subject Matter***

Claims 4-6, 11-13 and 17-21 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

Applicant's arguments filed 03/03/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that the staple of Jobe is not "for controlling the epiphyseal plate and for accommodating the growth of the bone in order to prevent the staple from being expelled by the bone during growth" and that the device of Oberlander "has not been designed to be cut and removed after the healing period", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, the Examiner sees no reason why the device of Jobe wouldn't be capable of performing the intended

use. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy

*Michael B. Priddy*  
May 24, 2004